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| 10/059,147 | 01/31/2002 | Lorin R. Sutton | 06975-211001 / Network 09 | 5982 |
| 26171 | 7590 | 09/07/2005 | EXAMINER | |
| FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | POLTORAK, PIOTR | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2134 | |
| DATE MAILED: 09/07/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,147

Applicant(s)

SUTTON ET AL.

Examiner

Peter Poltorak

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-29 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for priority based on U.S. Provisional Application No. 60/286,963 filed in April 30, 2001.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it does not identify the citizenship of each inventor.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7, 10, 23 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.
5. The term: "subsequently-exchanged messages" in claims 7 and 23 is not understood. It is not clear whether the term simply refers to multiple messages coming one after another into "the exchange system" or whether applicant intended to introduce a much more rigorous limitation.

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Also, the term is used inconsistently using a hyphen in one claim and not in another.

6. In addition the phrase in claims 7 and 23: "removing previously accepted messages having characteristics in common with subsequently-exchange messages for which the security condition is identified as including the hostile indicator".

It is not clear whether the limitation should be treated as though previously accepted messages are removed together with subsequently-exchange messages or whether applicant draws attention to removing previous messages that have similar characteristics to the subsequent messages.

7. Claims 10 and 26 are rejected by virtue of their dependence.
8. For purposes of further examination the above limitations are treated as best understood.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-5, 13-21 and 29 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Paul* (U.S. Patent No. 6052709).
10. As per claims 1, 4-5, 13-14, 17, 20-21 and 29 *Paul* teaches an apparatus and method for controlling delivery of unsolicited electronic mail in a system. *Paul* teaches that information contained in the received e-mail is identified and analyzed (col. 5 lines 1-10). This reads on "*inspecting a message being communicated to a first device in a message exchanging system that includes two or more devices and identifying characteristics of the message*".
11. *Paul* teaches forwarding the data extracted from the received mail (col. 5 lines 22-24) to verify against an exclusion list that includes identification data needed to determine the status of incoming email messages (col. 5 lines 56-62 and Fig. 2 and col. 5 line 63-col. 6 line 15). This reads on *comparing the characteristics of the message with data in the message exchanging system*".
12. *Paul* teaches that if the data match data stored in the corresponding data in the exclusion list the email is marked with a hostile indicator ("JUNK" status) and rejected (col. 6 lines 5-50 and col. 6 line 64-col. 7 line 1). If there is no match email is marked with an "OK" status code (col. 6 lines 52-55 and col. 7 lines 8-10) and. This reads on "*identifying a security condition based on the comparison of the message inspected and the stored data*".
13. *Paul* does not explicitly teach that stored data indicating characteristics of at least one other message communicated to a second device is used in comparison of the

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characteristics of the message. However, *Paul* teaches one or more "spam probes" that are created in order to identify (characteristics of) spam email (*col.4 lines 18-56*), which leads the examiner to believe that the characteristics of (spam email) other messages communicated to other devices are utilized in the filtering mechanism.

14. Even if stored data indicating characteristics of at least one other message communicated to a second device were not used in comparison of the characteristics of the message it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement such a modification. One of ordinary skill in the art would have been motivated to perform such a modification in order to utilize already obtained data.
15. As per claims 2-3, 15-16, 18-19 *Paul* teaches that: spam probes are intentionally set to attract multiple spammers (*col. 4 lines 24-26*), characteristics of the messages may include (*Fig. 3 and col. 6 lines 5-16*) but are not limited to (*col. 5 lines 16-19*) address information.
16. Claims 6-12, 22-28 are rejected under 35 U.S.C. 103(a) as obvious over *Paul* (U.S. Patent No. 6052709) in view of *Cotton* (U.S. Patent No. 6330590).
17. *Paul* teaches a method of identifying unwanted messages as discussed above.
18. As per claims 6, 8, 10-12, 22, 24, 26-28 *Paul* does not explicitly teach the following:
accepting a message if the security condition includes the indeterminate indicator,
comparing characteristics of a future message with characteristics of at least one message that has been tracked, assuming a message as hostile when comparison

of the characteristics reveals a threshold number of messages having a shared characteristic, and removing previously-accepted messages identified as hostile.

19. *Cotten* teaches utilizing a numerical signature identification code for the bulk message allowing quick and easy comparison of many message (*col. 2 lines 28-31*) which accepts a message if the security conditions include the indeterminate indicator (*col. 4 lines 34-36*), comparing characteristics of future messages with characteristics of at least one message that has been tracked and assuming a message when comparison of the characteristics reveals a threshold number of messages having a shared characteristic (*col. 4 lines 21-24*).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify *Paul's* invention in the manner as taught by *Cotten*. One of ordinary skill in the art would have been motivated to perform such a modification in order to further eliminate unwanted bulk email.

20. Removing previously-accepted messages identified as hostile would have been implicit.

21. Claims 6-12, 22-28 are rejected under 35 U.S.C. 103(a) as obvious over *Paul* (U.S. Patent No. 6052709) in view of *Hiroshi* (PAJ 2002-163341).

22. *Paul* teaches a method of identifying unwanted messages as discussed above.

23. As per claims 6, 8, 10-12, 22, 24, 26-28 *Paul* does not explicitly teach the following: accepting a message if the security condition includes the indeterminate indicator, comparing characteristics of future messages with characteristics of at least one message that has been tracked, the security condition as hostile when a comparison

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of the characteristics reveals a threshold number of messages having a shared characteristic, and removing previously-accepted messages identified as hostile.

24. *Hiroshi* teaches the security condition as hostile when comparison of the characteristics reveals a threshold number of messages having a shared characteristic [*Hiroshi*, 9-10].

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to identify the security condition as hostile when comparison of the characteristics reveals a threshold number of messages having a shared characteristic as taught by *Hiroshi*. One of ordinary skill in the art would have been motivated to perform such a modification in order to eliminate nuisance electronic mail.

25. Also, accepting and tracking a message if the security condition includes the indeterminate indicator would have been obvious to one of ordinary skill in the art at the time of applicant's invention given the benefit of controlling unwanted mail without the risk of deleting legitimate mail.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone

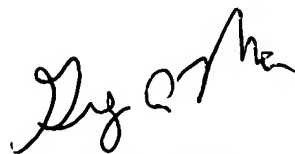
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number for the organization where this application or proceeding is assigned is
(571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature

9/2/05
Date


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100